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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,628	02/12/2001	Ursula Murschall	00/057 MFE	9521

7590

09/26/2002

ProPat, L.L.C.
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EXAMINER

CHEN, VIVIAN

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,628

Applicant(s)

MURSCALL ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 14-16, in the phrase "no marked increased", the term "marked" is a relative term which renders the claim indefinite. The term "marked" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Regarding claim 1 (line 6), the phrase "preferably " renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-28 of copending Application No. 09/421,068, in view of in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301).

Application 09/421,068 claims a white, biaxially oriented film comprising at least one layer comprising polyester and the specified cycloolefin, as well as other features such as the recited whiteness, opacity, and gloss values; and the presence of additional layers, etc. However, the reference does not explicitly disclose the recited UV stabilizer and flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the white film claimed in Application No. 09/421,068 in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have utilized conventional compounding methods such as masterbatches as indicated in claims 1-2 to incorporate the additives into the polyester composition. It would have been obvious to incorporate other fillers or pigments into the film in order to optimize the optical characteristics of the film as indicated in claims 1, 10, 14-16 in order to obtain the visual properties and physical properties required by a given application. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide protection for the inner core layers. One of ordinary skill in the art would have used conventional functional intermediate layers such as an adhesive layer between two film layers in order to improve the interlayer adhesion as indicated in claim 12. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-16 of copending Application No. 09/791,447, in view of in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301).

Application 09/791,447 claims a white, biaxially oriented film comprising at least one layer comprising polyester, white pigment, and the specified type and amount of cycloolefin, as well as other features such as the recited whiteness, opacity, gloss values, and the use of regrind material; and the presence of additional intermediate and/or outer layers, etc. However, the reference does not explicitly disclose the recited UV stabilizer and flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the white film claimed in Application No. 09/781,628 in order to improve durability, fire

resistance, and color stability. One of ordinary skill in the art would have also utilized conventional compounding methods such as masterbatches to incorporate the additives into the polyester composition. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide protection for the inner core layers. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 09/781,802 or claims 1-15 of copending Application No. 09/781,722 in view of in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301), and in view of POLYMER TECHNOLOGY DICTIONARY (hereinafter POLYMER TECHNOLOGY).

Applications Nos. 09/781,802 and 09/781,722 each claim a white, biaxially oriented film comprising at least one layer comprising polyester and the specified type and amount of cycloolefin, as well as other features such as the recited whiteness, opacity, gloss values, use of pigment, and the presence of additional intermediate and/or outer layers, etc. However, the

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reference does not explicitly disclose the use of regrind material and in the case of 09/781,722, the recited UV stabilizer or in the case of 09/781,802, the recited flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

POLYMER TECHNOLOGY discloses that it is well known in the art to incorporate regrind into thermoplastic materials (page 361).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate regrind material into the films claimed in Applications Nos. 09/781,802 and 09/781,722 in order to reduce costs and conserve resources. It also would have been obvious to one of ordinary skill in the art to incorporate both conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the claimed white films in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have utilized conventional compounding methods such as masterbatches to incorporate the additives into the polyester composition. Since the patent claims polyester compositions containing cycloolefin contents that are substantially

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comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

SASAKI ET AL (US 5,843,578),

in view of REIDEL ET AL (US 5,869,586) or MINAMI ET AL (US 5,179,171) or

KAJIURA ET AL (US 4,614,778),

and in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or

BALOG ET AL (US 3,950,301),

and in view of POLYMER TECHNOLOGY DICTIONARY (hereinafter POLYMER TECHNOLOGY).

SASAKI ET AL discloses a biaxially oriented film comprising polyester and 3-40 wt% of an incompatible cyclic olefin resin (line 25, col. 4 to line 18, col. 5), wherein the film has good gloss, whiteness, and opacity (lines 51-56, col. 5; lines 18-24, col. 10) as recited in claims 1, 14-16, wherein the film may further contain pigments, stabilizers, and other additives for improved opacity (lines 19-33, col. 5), and may be further laminated and/or coated with a functional layer (lines 42-45, col. 9; line 65, col. 9 to line 12, col. 10) as recited in claims 10-12. However, the reference does not explicitly disclose the recited Tg values of the cycloolefin.

REIDEL ET AL discloses known cycloolefin polymers derived from norbornene, tetracyclododecene and/or cyclopentene (lines 25-50, col. 8) which have typical Tg values of 143 C to 193 C (Table) as recited in claims 1, 3-5, 14-16. MINAMI ET AL discloses known cycloolefin polymers derived from octahydronaphthalene-based monomers and optionally norbornene and/or cyclopentene (columns 6-8; line 52, col. 10 to line 9, col. 11) which have Tg values of 10-200 C (lines 15-20, col. 13) as recited in claims 1, 3-5, 14-16. KAJIURA ET AL discloses known cycloolefin polymers derived from octahydronaphthalene-based monomers and optionally norbornene and/or cyclopentene (columns 4-6; 18-48, col. 10) which have Tg values of 30-220 C (lines 14-20, col. 8) as recited in claims 1, 3-5, 14-16.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight

of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

POLYMER TECHNOLOGY discloses that it is well known in the art to incorporate regrind into thermoplastic materials (page 361).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate known cycloolefin polymers as disclosed in REIDEL ET AL or MINAMI ET AL or KAJIURA ET AL in the polyester film of SASAKI ET AL in order to produce white films with useful mechanical and optical properties. It also would have been obvious to incorporate regrind material into the prior art films in order to reduce waste and conserve resources as disclosed in POLYMER TECHNOLOGY. One of ordinary skill in the art would have incorporated combination of conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and/or organic phosphorus flame retardants into at least one layer of the disclosed white film using established compounding methods in order to improve durability, fire resistance, and color stability. It would have been obvious to use conventional film-finishing methods, additional pigments or additives, and/or additional surface layers or coatings in order to optimize the optical characteristics of the film as indicated in claims 1, 10, 14-16 in order to obtain the visual and physical properties required by a given application. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide added protection for the inner core layers. One of ordinary skill in the art would have used conventional functional intermediate layers such as an adhesive layer between two film layers in order to improve the interlayer adhesion as

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indicated in claim 12. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

3. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

JAPANESE PATENT APPLICATIONS 05-230253 or 05-009319 or 05-140349 or 11-035717 (hereinafter JP '253 and JP '319 and JP '349 and JP '717, respectively),

in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301),

and in view of POLYMER TECHNOLOGY DICTIONARY (hereinafter POLYMER TECHNOLOGY).

JP '253 discloses a biaxially oriented film comprising polyester and 5-50 wt% of an incompatible cyclic olefin resin having a typical Tg of 129-134 C (Tables 1, 3), wherein the film has good gloss, whiteness, and opacity and wherein the film may further contain pigments, stabilizers, and other additives ([0028]) as recited in claim 1, 3-5, 10, 14-16, and may be further laminated and/or coated with additional layers ([0029]) as recited in claims 11-12.

JP '319 discloses a biaxially oriented film comprising polyester and 5-50 wt% of an incompatible cyclic olefin resin ([0010]) having a typical Tg of 98-100 C (Table 3), wherein the film has good gloss, whiteness, and opacity, and wherein the film may further contain pigments,

stabilizers, and other additives ([0030]) as recited in claims 1, 3-5, 10, 14-16, and may be further laminated and/or coated with additional layers ([0032]) as recited in claims 11-12.

JP '349 discloses a biaxially oriented film comprising polyester and 5-50 wt% of an incompatible cyclic olefin resin ([0009]) having a typical Tg of 135-205 C (Table 1), wherein the film has good gloss, whiteness, and opacity, and wherein the film may further contain pigments, stabilizers, and other additives ([0029]) as recited in claims 1, 3-5, 10, 14-16, and may be further laminated and/or coated with additional layers ([0031]) as recited in claims 11-12.

JP '717 discloses an opaque biaxially oriented film comprising polyester and 5-80 parts by weight of an incompatible cycloolefin resin having a typical Tg of 120-270 C (Abstract) wherein the film may further contain pigments, stabilizers, and other additives ([0061]) as recited in claims 1, 3-5, 10, 14-16, which may be further laminated and/or coated with additional layers ([0070]) as recited in claims 11-12.

However, the references do not explicitly disclose the specified UV stabilizers and flame retardants or the use of regrind.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of

masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

POLYMER TECHNOLOGY discloses that it is well known in the art to incorporate regrind into thermoplastic materials (page 361).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the polyester/cycloolefin blends as disclosed in JP '253 and JP '319 and JP '349 and JP '717 as the base layer of a multilayer film in order to produce white films with useful mechanical and optical properties. It also would have been to incorporate conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the white film claimed in Application No. 09/421,068 in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have utilized conventional compounding methods such as masterbatches as indicated in claims 1-2 to incorporate the additives into the polyester composition. It would have been obvious to use conventional film-finishing methods, additional pigments or additives, and/or additional surface layers or coatings in order to optimize the optical characteristics of the film as indicated in claims 1, 10, 14-16 in order to obtain the visual and physical properties required by a given application. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide added protection for the inner core layers. One of ordinary skill in the art would have used conventional functional intermediate layers such as an adhesive layer between two film layers in order to improve the interlayer adhesion as indicated in claim 12. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason

to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

Response to Arguments

4. Applicant's arguments filed 6/24/2002 have been fully considered but they are not persuasive.

(A) Applicant argues that the prior art of record fails to specifically disclose or suggest the use of cycloolefins in reducing yellowing when regrind is used. While the examples in the specification indicate that certain cycloolefin-containing compositions produce films with reduced yellowing in films incorporating regrind material, the showing in the specification is not commensurate in scope with the present claims, especially in regards to the type, Tg, and amount of cycloolefin present, the type and amount of additives such as the type of white pigment and the use of brighteners, etc. Applicant has not provided probative evidence that similar non-yellowing properties are present in films containing differing amounts of COCs, COCs of different Tg values, or the use of different types and/or amounts of pigments and additives, especially when the specification fails to clearly set forth the compositions of the comparative Examples.

(B) Applicant argues that the prior art fails to explicitly disclose or suggest the use of "additives, conventional film-finishing methods, pigments, and/or surface layers". However, the prior art of record contains numerous references to the use of such well known additional components or treatments. As illustrative, non-limiting examples, see SASAKI ET AL (lines 19-

33, col. 5; lines 42-45, col. 9; line 65, col. 9 to line 12, col. 10) or JP '253 ([0027] to [0029]).

Similar statements may be found in many of the relied upon references. Applicant has not provided any probative evidence of unexpected results with regard to these features.

(C) Applicant argues that the JP '717 fails to explicitly disclose white films. However, since the disclosed films are stated to be suitable as writing materials and synthetic papers, one of ordinary skill in the art would reasonable assume that the film is either inherently white or could readily be made so with the use of conventional pigments and/or coatings. Applicant has not provided any evidence to the contrary.

(D) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., orientation and heat-setting conditions, or surface treatments as set forth in claims 11-13, 15) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

September 20, 2002



Vivian Chen
Primary Examiner
Art Unit 1773